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LAW OFFICES OF
STEPHEN E. FELDMAN, P.C.
12 East 41st Street
Suite 1302
New York, New York 10017
☎ (212) 532-8585 Fax (212) 532-8598



To: John P. Sheehan **From:** Stephen E. Feldman
Fax #: 703-872-9736 **Re:** 08/637,802
Tel #:
Date: December 2, 2003
Pages: , including this cover sheet

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

12/2/2003

#37

Applicant(s) : A. P Eccles

Application No.: 08/637,802

Art Unit: 1742

Filed : May 8, 1955-1996

Examiner: J. P. Sheehan

For : SILVER ALLOY COMPOSITIONS

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

COMMUNICATION UNDER 37 CFR 1.111

This Communication is submitted under the provisions of 37 CFR 1.111 and is responsive to the Office Action dated August 20, 2003 pursuant to which all of the claims in the above captioned application, except for claims 38 and 40 stand rejected under 35 USC 112, first paragraph and 35 USC 103(a).

35 USC 112, first paragraph, is cited to support the rejection of claims 33 and 36-46 as new matter having no support in the specification.

This rejection is respectfully traversed and its reconsideration is respectfully solicited.

Although the above captioned application is a Continuation Application, it is respectfully submitted that it is deemed to be a "new" application. As such, it is further respectfully submitted that the claims contained therein are deemed to be originally filed new claims and are, therefor, part of the specification or disclosure. Furthermore, while the alloy ingredients recited in claims 33 and 36-46 are not set forth with particularity in the specification, it is respectfully submitted that they are included in the range of ingredients set forth in the alloys disclosed on page 2 at lines 30-33 and page 4 at lines 10-28.

In view of the foregoing, it is respectfully submitted that the 35 USC 112 rejection is not tenable and should be withdrawn.

US Patent 5,039,479 to Bernhard, et.al. and UK Application 2,255,348 to Rateau, et.al. are relied upon to support the 35 USC 103(a) rejection of claims 24-37, 39 and 41-46.

This rejection is also respectfully and its reconsideration is respectfully solicited.

The field of metallurgy is similar to the field of chemistry in that if one or more atoms are added to or removed from a chemical compound or even if the position of an atom in a molecule is changed, the altered compound will exhibit different, unforeseeable chemical and physical properties than the original compound.

So, too, in the field of metallurgy. If one or more ingredients are added to or removed from an alloy mixture, the resulting properties of the altered alloy can not be predicted.

In Example 2 on page 8 of applicant's application, two silver alloys having the same components in the same percentage amounts by weight are presented (representative of the silver alloys disclosed in the Bernhard, et.al. patent), but only one of them includes germanium in an amount of 0.125% by weight. Surprisingly, the silver alloy containing germanium was found to have a hardness of about 15% greater than the silver alloy without germanium and an increased malleability; i.e., "work", at 75%. These are submitted to be significant and unexpected desirable properties.

While the patent to Rateau, et.al. discloses silver alloys containing germanium, it is respectfully submitted that the Rateau, et.al. alloys it is submitted that they can not be equated with those of applicant's claimed invention.

The Rateau, et.al. silver alloy compositions are ternary (i.e., three component) compositions while those of the claimed invention contain from five to eight components and include silicon.

In an effort to reduce the brittleness of their silver alloy compositions, Rateau, et.al. sought to replace the cadmium component of their former compositions. When germanium was used to replace the cadmium component of their silver alloy compositions, Rateau, et.al. found that the presence of germanium did, indeed, reduce the brittleness of their silver alloy compositions (p. 3, ll. 26-29). This was the Rateau, et.al. discovery! There is no suggestion, much less disclosure, in the Rateau, et.al. patent that the presence of germanium in multi-component silver alloys would increase hardness and improve "workability" as applicant has discovered and shown in his Examples.

Most significantly, the ternary silver alloy compositions in the Rateau, et.al. patent are cast and then annealed. By contrast, the multi-component silver

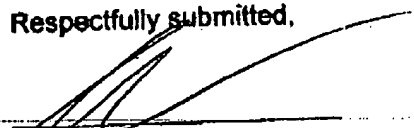
alloys of applicant's claimed invention are not only cast and annealed, they are also "worked"; i.e., made progressively thinner, before they are annealed. Consequently, it is respectfully submitted that comparing the hardness results obtained by Rateau, et.al. (pp. 5 and 6) with applicant's silver alloys as provided in applicant's Example 1 (pp. 6-8 and Table I, p.8) would not be realistic. Alloys that have been cast, "worked" and then annealed, as in applicant's claimed invention, exhibit entirely different properties of hardening, "workability", flexibility, etc. than those that are only cast and then annealed as in the Rateau, et.al. patent.

It is of further significance to note that none of the Rateau, et.al. silver alloys set forth in their Examples contains less than 1.5% by weight germanium and that the lower limit of 0.5% by weight germanium is only *theoretical* (p. 4, ll. 5 and 6). In other words, a guess that 0.5% germanium would be effective. By comparison, applicant's claimed silver alloys can contain as little as 0.1% by weight germanium (claims 38 and 40). At best, it is respectfully submitted that Rateau, et. al. suggest that germanium be tried and experiment with. However, it is respectfully submitted that this can not support an obviousness rejection

In view of the foregoing remarks it is respectfully submitted that neither the patent to Bernhard, et.al. nor the patent to Rateau, et.al., whether considered singly or in combination, render applicant's claimed silver alloy compositions obvious. Favorable reconsideration of this case and passing the claims herein to an early issue are, therefor, respectfully solicited.

Please charge any addition fees to Deposit Account No.06-0515

Respectfully submitted,


Stephen E. Feldman
Reg. No. 22,473

12 East 41st Street
New York, NY 10017

212-532-8585